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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/506,808 02/18/00 MORI

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EXAMINER

TM02/0521

MATTINGLY, STANGER & MALUR, P.C.
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ALEXANDRIA VA 22301

NGUYEN, C

ART UNIT

PAPER NUMBER

2165

DATE MAILED:

05/21/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/506,808

Applicant(s)
Mori et al.

Examiner
Cuong H. Nguyen

Art Unit
2165

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Feb 28, 2001

2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 16-33 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 16-33 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☒ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☒ Certified copies of the priority documents have been received in Application No. 08/916,154.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 7

20) ☐ Other: _____

DETAILED ACTION

1. This Office Action is the answer to the amendment on 2/28/2001; which paper has been placed of record.
2. Claims 16-33 are pending in this application.

Priority

3. Acknowledgment is made of applicants' claim for priority under 35 U.S.C. §119(a)-(d). The certified copy has been filed in parent Application No. 08/916,154, filed on 9/02/1997.

Response to Amendment

4. Applicants' arguments received on 2/28/2001 have been fully considered but they are not persuasive with previous cited references for 35 U.S.C. §103(a) rejections.

Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee

pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5A. Referring to the argument on the paper received on 2/28/2001 (page 9, 1st paragraph), that "Chavez is not relevant to either the field of the invention or to the field of the Fujisaki disclosure", the examiner submits that this is not correct. Chavez's reference is related to an agent market place for buying and selling goods, this reference suggests a concept of doing business which comprising auction business; and the available public knowledge such as this idea of Chavez's reference would be implemented in Fujisaki's invention by one of ordinary skills in the art (the art here is business method art, it comprises auctions: a type of business method).

5B. Referring to the argument on the paper received on 2/28/2001 (page 10, 1st paragraph), that "Chavez does not resolve the auction by the "highest acceptable price", but by the "lowest acceptable price" established by the seller", the examiner submits that "a maximum margin" in the pending claims refers to both highest and/or lowest margins (e.g. plus-and-minus tolerances of a price's window in which a price can varies).

5C. On pages 9-10 of the amendment, the applicants argue points/features that are not in the submitted claims. Although operational characteristics of a system may be apparent from the specification, the examiner will not read such characteristics into the claims when they cannot be clearly connected to the structure recited in the claims. When given a broadest reasonable interpretation, the claims on examination sweep in the prior art, and the prior art would have directed an artisan of ordinary skill to make the combination cited by the examiner. The examiner submits that cited prior art disclosed structures that meet the claimed limitations although the matter is expressed in different language.

5E. It is reasonable that analogous modifications of prior art would be apparent to those skilled in the art at the time of invention without departing from the scope and spirit of these inventions. Although cited inventions may have been described in connection with specific preferred embodiments, it should be understood that their limitations as disclosed should not be limited to such specific embodiments.

Specification Objection

6. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 16-33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fujisaki (US Pat. 4,789,928), in view of Chavez et al. (XP-002099613).

A. Referring to claim 16: The claim is directed to a computer-implemented method for performing an auction, Fujisaki obviously shows a similar method with a host terminal connected to a plurality of bidder terminals via a network, comprising:

- a storage device to collect prices and a highest possible range/(maximum margin)to pay for a product from bidders (see Chavez et al.'s article pp.6, 9 (e.g. pg.9 para.2-3); see also Fujisaki '928 2:5-20);

- a processor, connected to said storage device, executing following steps according to a software program (not disclosed) (Fujisaki '928 1:62 to 2:28, see also see **Chavez et al.**'s article):

providing information on a product to be auctioned via a network (see Fujisaki '928 Fig.12, 1:62 to 2:39, see also Chavez et al. Pg.6, 2nd paragraph);

Fujisaki ('928) fails to expressly teach about a proposed maximum margin from bidders in an auction process.

However, Chavez et al.'s article suggests that missing limitation; Chavez et al. obviously suggest steps of:

- collecting a price for the product (this is also obvious in **Fujisaki's** patent), and a highest possible price/(a maximum margin) of the price acceptable to pay proposed by each bidder via the network (see **Chavez et al.**'s article, pp.4, 7, 9-10); and

- if the price proposed by one bidder equals to another bidder, selecting the highest possible price/(the maximum margins) of the bidders (see **Chavez et al.**'s article, pp. 1-3, 9, 10-11 about "the best possible price/deal" ; see also Fisher et al. (US Pat. 5,835,896) 12:62 to 13:24; Ausubel (US Pat. 6,026,383) 9:49-65).

The examiner submits that one of ordinary skills in the art at the time of the invention would have found these claim's limitations very obvious with inherent steps as suggested by cited prior art; prior art's limitations are not necessary spelled-out exactly claimed languages, because these prior arts are also directed to a similar process for obtaining A highest possible price/deal in an auction process. These prior art are not limited to the described embodiments in their inventions. It is reasonable that analogous modifications/variations of the described method and system of the cited prior art would be apparent to those skilled in the art without departing from the scope and spirit of the invention.

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Fujisaki's invention with Chavez et al. 's suggestion, because these information are readily available at that time, and they would be recognized as providing a negotiation window between buyers and seller, or between bidders with selling agents an autonomous negotiate and making the "best possible deal" on the user behalf (or mutually benefit on both buyer and seller sides).

B. Referring to claims 24, 32, 33: The limitations of these claims obviously recite the same claim's limitations as claim 16

above. The same analysis and reasoning set forth in the rejection of claim 16 applied to this claim because they obviously cover means/apparatus/program codes using to perform similar claimed functions/tasks that described in claim 16.

C. Referring to claim 17:

The rationales for rejection for claim 16 are incorporated herein.

Chavez et al. obviously show a step of selecting a bidder with a highest possible price/(largest maximum margin) (see **Chavez et al.**'s article, pp.4, 7, 9-10); moreover, the means/(computer instructions) for performing above tasks clearly are not an inventive concept to one with ordinary skills in the art since various problems in different fields have been solved by writing computer codes of related steps (e.g. selecting a highest value).

D. Referring to claim 25: The limitations of this claim recite the same claim's limitations as claim 17 above. The same analysis and reasoning set forth in the rejection of claim 17 applied to this claim because it covers an apparatus for obviously performing an auction having bidders on a network with means to perform exactly steps of claim 17.

E. Referring to claim 18: Claim 18 is directed to an auction method wherein a maximum margin is a difference between a price acceptable to pay and a desired price.

The rationales for rejection for claim 17 are incorporated herein.

The examiner submits that claim 17 's limitation already including claim 18 's limitation according to the examiner's interpretation. Moreover, the further explanation of claim 18 clearly are not an inventive concept to one with ordinary skills in the art (ie., a maximum margin is a difference between the accepted price and the desired price); many analogous definitions of a maximum margin have been used).

F. Referring to claim 26: The limitations of this claim recite the same claim's limitations as claim 18 above. The same analysis and reasoning set forth in the rejection of claim 18 applied to this claim because it covers an apparatus for obviously performing an auction having bidders on a network with means to perform exactly steps of claim 18.

G. Referring to claim 19: Claim 19 is directed to an auction method having a step of collecting information of a product (e.g. bidding prices).

The rationales for rejection for claim 16 are incorporated herein.

The examiner submits that claim 16 's limitation already including claim 19 's limitation (underlined above). Moreover, the further explanation of claim 19 clearly are not an inventive concept to one with ordinary skills in the art since it is notoriously well-known (ie., collecting data for a specific purpose).

H. Referring to claim 27: The limitations of this claim recite the same claim's limitations as claim 19 above. The same analysis and reasoning set forth in the rejection of claim 19 applied to this claim because it covers an apparatus for obviously performing an auction having bidders on a network with means to perform exactly steps of claim 19.

I. Referring to claim 20: Claim 20 is directed to an auction method wherein a resolving step resolves a bidding based on received prices.

The rationales for rejection for claim 12 are incorporated herein.

The examiner submits that claim 19 's limitations obviously include claim 20 's limitations according to his broad interpretation. Moreover, the further explanation of claim 20

clearly are not an inventive concept to one with ordinary skills in the art since resolving a bidding matter based on submitted price is notoriously well-known, and being a fundamental instrument in many auctions.

J. Referring to claim 28: The limitations of this claim recite the same claim's limitations as claim 20 above. The same analysis and reasoning set forth in the rejection of claim 20 applied to this claim because it covers an apparatus for obviously performing an auction having bidders on a network with means to perform exactly steps of claim 20.

K. Referring to claim 21: Claim 21 is directed to an auction method having a step of continuing an auction after a bidding decision.

The rationales for rejection for claim 16 are incorporated herein.

The examiner submits that this limitation is obvious in Fujisaki's patent (see '928 Figs. 12 and 21; see also Ausubel (US Pat. 6,026,383) 3:1-16 and 9:36-40). Moreover, this step of claim 21 clearly is not an inventive concept to one with ordinary skills in the art (i.e. CPU are automatically reset by a software program to start another cycle of bidding after going through "a cycle", e.g., for another product/step).

L. Referring to claim 22: Claim 22 is directed to an auction method wherein a collection step is performed before an auction starts.

The rationales for rejection for claim 16 are incorporated herein.

The examiner submits that claim 's limitation is really a designer 's choice before a bidding determination: a software program could be written to collect bidding prices before or during an auction. Moreover, this limitation clearly is not an inventive concept to one with ordinary skills in the art since it is a fundamental concept for many auctions.

M. Referring to claim 30: The limitations of this claim recite the same claim's limitation as claim 22 above. The same analysis and reasoning set forth in the rejection of claim 22 applied to this claim because it covers a computerized apparatus to perform an auction on a network having exactly limitations of claim 22.

N. Referring to claim 23, 31: These claims are directed to an auction concept comprising a feature of determining a successful bidder with a highest proposed price.

The rationales for rejection for claim 16 are incorporated herein.

The examiner submits that claim 17 's limitation obviously including claims 23, 31 limitations. Moreover, this limitation clearly is not an inventive concept to one with ordinary skills in the art since it is notoriously well-known as a determined factor in auctions using a comparison for a highest proposed price. This claim is rejected based on 35 USC 103(b).

Conclusion

8. Claims 16-33 are rejected.

9. The following references (US. Patents & articles about are cited:

- Chavez et al., "Kasbah: an agent marketplace for buying and selling goods", from the web of asc/pattie@media.mit.edu, posted on April 1996.
- Rockoff et al., Design of an Internet-based system for remote Dutch auctions, from Internet Research: Electronic Networking Applications and Policy, vol.5 no.4, posted date: 1995, pp.10-16.
- Lee, Electronic brokerage and electronic auction: the impact of IT on market structures, Proceedings of the 29th Annual Hawaii International Conference on System Sciences, 1996-IEEE, pp.397-406, posted date: 3/01/1996.

- Feldman et al., Auctions: theory and applications, from International Monetary Fund Staff Papers, v40n3, pp: 458-511, posted Sept. 1993.
- WO 0118713, (Levin et al.), priority date: 9/07/1999, Electronic commodity exchange system having dynamic transaction filters.
- WO 2116815, (Han et al.), priority date: 8/31/1999, A computer based fractional auctioning system.
- WO 0075848, (Kinney et al.), priority date: 6/08/1999, Method and system for differential index bidding in online auctions.
- Fujisaki (US Pat. 4,789,928), filed on 1/30/1987, about an auction information processing method and system.
- Nymeyer (US Pat. 3,581,072), filed on 3/28/1968, about an auction market computation system; wherein a margin number is used as a margin provision for price increment (see 12:18-26, 25:32-39; 26:15-27, 27:16-19, 28:6-43).
- Fisher et al. (US Pat. 5,835,896), filed on 3/29/1996, about a method and a system for processing and transmitting electronic auction information; wherein a "Proxy Bidding" feature is utilized, this is similar to the applicants' claim for "maximum margin bidding".

- Ausubel (Pat. 6,026,383), filed on 1/04/1996, a system and a method for an efficient dynamic auction for multiple objects.
- Woolston (US Pat. 5,845,265), filed on 11/07/1995, about consignment nodes, wherein this invention discloses an electronic market maker for collectable and used goods, a means for electronic presentment of goods for sale.

10. Notes: Test of obviousness is not whether features of secondary reference may be bodily incorporated into primary reference's structure, nor whether claimed invention is expressly suggested in any one or all of references; rather, test is what combined teachings of references would have suggested to those of ordinary skill in art. The test for obviousness under 35 U.S.C. 103 is not the express suggestion of the claimed invention in any of the references but what the references taken collectively would suggest.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Cuong H. Nguyen, whose telephone number is (703)305-4553. The examiner can normally be reached on Mon.-Fri. from 7AM-3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent a. Millin, can be reached on (703)308-1065.

S.N.: 09/506,808
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Any response to this action should be mailed to:

Amendments

Commissioner of Patents and Trademarks

c/o Technology Center 2100

Washington, D.C. 20231

or faxed to: (703) 308-9051

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)305-3900.

Cuong Nguyen
May 08 2001